as follows:

Groups 1-7, claims 1-2, 4 and 6, drawn to a method for diagnosing prostate cancer, or metastatic prostate cancer, or the onset of metastatic prostate cancer, comprising measuring the level of prostate specification, with one of SEQ ID NO: 1, 2, 3, 4, 5, 6, or 7.

Groups 8-14, claims 3, 5, and 6, drawn to a method for staging prostate cancer, or monitoring change in a stage of prostate cancer, comprising measuring the levels of PSG with one of SEQ ID NO: 1, 2, 3, 4, 5, 6, or 7.

Upon election of any of Groups 1-7, the Examiner suggests that further election of the following patentably distinct species, namely prostate cancer or metastatic prostate cancer, is required.

Upon election of any of groups 8-14, the Examiner suggests that further election of the following patentably distinct species, namely staging prostate cancer or changes in the stage, is required.

The Examiner suggests that the inventions listed as Groups 1-14 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature. Specifically, the

Examiner suggests that the PSGs are structurally different. In addition, the Examiner suggests that the methods of Groups 1-7 and 8-14 are distinct because they have different objectives.

Applicants respectfully traverse this requirement.

At the outset, it is respectfully pointed out that the Examiner's suggestion that "the inventions listed as Groups 1-14 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature" directly contradicts both the Search Report and the Written Opinion issued by this same Examiner in the PCT application of which this case is the U.S. National Stage.

Further, MPEP §803 provides two criteria which must be met for a restriction requirement to be proper. The first is that the inventions be independent or distinct. The second is that there would be a serious burden on the Examiner if the restriction is not required. A search of the prior art relating to pending claims 1-6, at least with respect to SEQ ID NO:1, has already been performed by this Examiner in the PCT application. Thus, there is clearly no burden whatsoever placed upon the Examiner by including all claims in this case, since the full claim set was already searched and examined by the Examiner in

the PCT application.

Further, the Examiner has provided no evidence whatsoever in this Restriction Requirements to support the contention that the Groups have acquired separate status in the art.

Accordingly, since this Restriction Requirement does not meet both criteria as set forth in MPEP § 803 to be proper, it is respectfully requested that this Restriction Requirement be withdrawn.

However, in an earnest effort to be completely responsive, Applicants elect to prosecute Group 1, SEQ ID NO:1, with traverse.

Since Applicants have elected Group 1, with traverse, the Examiner also suggests that a species election between prostate cancer and metastatic prostate cancer must be made.

Applicants respectfully traverse this species election requirement.

In accordance with MPEP § 808.01, an election of species should be made when a generic claim recites such a multiplicity of species that an unduly extensive and burdensome search is required. In the instant case, however, both prostate cancer and metastatic prostate cancer have already been searched by the same Examiner in the PCT application. Thus, there is clearly no undue

burden in this case by including both prostate cancer and metastatic prostate cancer in this case. Further, even if the search had not already been performed, inclusion of only two species in a generic claims can clearly not be considered to cause an unduly extensive or burdensome search. Accordingly, reconsideration of this species election requirement is respectfully requested.

However, in an earnest effort to advance the prosecution of this case, Applicants elect prostate cancer with traverse.

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record.

Respectfully submitted,

Kathleen A. Tyrrell
Reg. No. 38,350

Date: **April 26, 2002**

LICATA & TYRRELL P.C.
66 E. Main Street
Marlton, New Jersey 08053

(856) 810-1515